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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lafarge Road Marking, Inc.

Serial No. 76351777 and Serial No. 76351778

Kenneth A. Clark of Rankin, Hill, Porter & Clark LLP for
Lafarge Road Marking, Inc.

Brian D. Brown, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Seeherman, Walters and Chapman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On December 20, 2001, Lafarge Road Marking, Inc. (a
Delaware corporation) filed two applications to register on
the Principal Register the marks, SAHARA WATERMIX
("watermix" disclaimed) (76351777) and SAHARA WATERDRY
(76351778), both for "road and traffic marking paint" in
International Class 2. The applications are each based on

applicant's assertion of its bona fide intention to use the respective marks in commerce on the identified goods.

Registration has been refused in each application under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark (SAHARA WATERMIX or SAHARA WATERDRY), when applied to its identified goods, so resembles the registered mark SAHARA for "masonry waterproofing coating" in International Class 1,¹ as to be likely to cause confusion, mistake or deception.

When the refusal to register was made final, applicant appealed in each application. Applicant and the Examining Attorney have filed briefs, but applicant did not request an oral hearing.

In view of the common questions of law and fact which are involved in these two applications, and in the interests of judicial economy, we have consolidated the appeals for purposes of final decision. Thus, we have issued this single opinion.

We affirm the refusals to register. In reaching this conclusion, we have followed the guidance of the Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177

¹ Registration No. 2311751 issued January 25, 2000 to Davis Paint Company.

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USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The Examining Attorney contends that each of applicant's marks (SAHARA WATERMIX and SAHARA WATERDRY) is very similar to the registered mark SAHARA, as all of the marks share the identical word "SAHARA," which is the entirety of registrant's mark and is the first word in each of applicant's marks; that applicant's addition of the term WATERMIX or WATERDRY does not obviate the likelihood of confusion; that each of applicant's marks is similar in sound, appearance, connotation and overall commercial impression to the cited registered mark; that the goods (registrant's "masonry waterproofing coating" and applicant's "road and traffic marking paint") are related as evidenced by the Examining Attorney's submission of (i) third-party registrations showing that the same companies offer both products under a single mark, and (ii) printouts

of pages from various web sites (including the cited registrant's web site) showing the same companies offer both products (some under the same trademark and some under different marks); that even if the purchasers are sophisticated, they are not immune from confusion as to the source of the goods; and that doubt is resolved in favor of registrant.

Applicant concedes that each of its marks "is somewhat similar in appearance and sound to the registered mark SAHARA" (briefs, p. 5). However, applicant strongly contends that applicant's and the cited registrant's goods do not move in the same channels of trade and are not marketed to the same consumers; that the relevant purchasers of applicant's goods, being governmental entities that build roads, and/or road construction and maintenance contractors, are sophisticated and knowledgeable; and that the marks, when considered in their entireties, are sufficiently different to avoid a likelihood of confusion.

Turning first to a consideration of the cited mark and each of applicant's marks, we find that they are very similar in sound, appearance, connotation and commercial impression. Registrant's mark is the word SAHARA, and each of applicant's marks begins with the word SAHARA. The

addition by applicant of the descriptive word "WATERMIX" in one mark and the word "WATERDRY" in the other is not a sufficient distinction to render these marks dissimilar. Our primary reviewing Court has held that in articulating reasons for reaching a conclusion on the question of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature or portion of a mark. That is, one feature of a mark may have more significance than another. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987); and *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985).

Because the additional words in applicant's marks are descriptive in one case and suggestive in another, it is the dominant word SAHARA that customers will look to as the source identifier. Consumers may see the additional words WATERMIX and WATERDRY as indicating a type or feature of the particular product with which it is used, but they will view these marks as variants of the mark SAHARA, and will perceive the products as all emanating from the same source.

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Turning next to a consideration of the respective goods, it is well settled that goods (or services) need not be identical or even competitive to support a finding of likelihood of confusion; it being sufficient that the goods (or services) are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See *In re Peebles Inc.*, 23 USPQ2d 1795, 1796 (TTAB 1992); and *In re International Telephone and Telegraph Corporation*, 197 USPQ 910 (TTAB 1978).

It has been repeatedly held that, when evaluating the issue of likelihood of confusion in Board proceedings regarding the registrability of marks, the Board is constrained to compare the goods and/or services as identified in the application with the goods and/or services as identified in the registration. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank of Commerce, N. A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

In this case, the registered mark is for "masonry waterproofing coating," while applicant intends to offer

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"road and traffic marking paint." The Examining Attorney submitted printouts of two third-party registrations, based on use in commerce, listing these types of goods in connection with the same marks. See Registration No. 2273781 for, inter alia, "traffic paint" and "masonry coatings for chemical resistance and waterproofing"; and Registration No. 0613418 for, inter alia, "traffic paint," "cement and masonry paint" and "foundation coatings."

When considering the third-party registrations submitted by the Examining Attorney, we are aware that such registrations are not evidence that the marks shown therein are in use or that the public is familiar with them. Such third-party registrations nevertheless have some probative value to the extent they may serve to suggest that such goods and services are of a type which emanate from the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, footnote 6 (TTAB 1988).

The Examining Attorney also relies on printouts of pages from several web sites to show that entities offer both traffic marking paint and masonry coatings under a single mark. See *Bennette Paint* -- "Traffic Paint" and "Masonry Coating"; *Coronado Paint* -- "Masonry Surface

Conditioner" and "Traffic Paint"; and Century Labs --
"Water Based Sealer" and "Traffic Paint."²

In view of the foregoing evidence, we find that masonry waterproofing coatings and road and traffic marking paint are related within the meaning of the Trademark Act.

While applicant contends that the trade channels and purchasers are different, applicant did not offer evidence relating thereto. Rather, applicant requested that the Board take judicial notice (i) "that road and traffic marking paint is marketed to governmental entities (e.g., federal, state, and local government street and highway departments) that build and maintain roads and streets and/or road construction and maintenance contractors who perform such services for such governmental entities," and (ii) "that masonry waterproofing coating is not sold to governmental entities that build and maintain roads and streets and/or road construction and maintenance contractors who perform such services for such governmental entities." (Briefs, p. 3.)

² The cited registrant's web site shows that it offers both products for sale, albeit not under the same trademark. Davis Paint -- "SAHARA Masonry WaterProofer" and "DAVIS Latex Traffic & Zone Marking Paint."

The Board denies applicant's requests for judicial notice. Applicant's assertions do not rise to the type of facts which we may judicially notice. See Fed. R. Evid. 201 and TBMP §704.12(b) (2d ed. June 2003).

We acknowledge that applicant's identification of goods "road and traffic marking paint" does indicate a specialized product sold to sophisticated purchasers. However, there is no limitation in the registrant's identification of goods as to consumers or channels of trade. Thus, we must presume that registrant's "masonry waterproofing coating" is sold in all normal channels of trade (wholesale, retail superstores, hardware stores) to the usual classes of purchasers, including building contractors and governmental entities.³ See Octocom Systems Inc. v. Houston Computers Services Inc., supra; and CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983).

Because the evidentiary record furnished by the Examining Attorney demonstrates that road and traffic

³ Applicant originally argued that registrant's goods would be sold to purchasers who "buy paint off the shelf in stores where the products are available to the general public." (Applicant's responses filed September 9, 2002, p. 4.) In its briefs on appeal (p. 4), however, applicant changed its argument (without submitting any evidence in support thereof), and asserted that registrant's goods are not sold to governmental entities, but are marketed and sold to "architectural building contractors and persons who maintain such masonry structures."

marking paint and masonry waterproofing coating may emanate from a single source, even the sophisticated consumers who are the common purchasers of such goods are likely to assume a common source, if the goods are sold under the confusingly similar marks involved herein.

As discussed above, applicant argues that the purchasers of the respective goods are commercial entities with sophisticated purchasing personnel who are able to distinguish between the marks SAHARA and SAHARA WATERMIX or SAHARA WATERDRY. Even assuming the sophistication of the purchasers of the goods, "even careful purchasers are not immune from source confusion." See *Wincharger Corporation v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289 (CCPA 1962); *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999); and *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). See also, *In re Hester Industries, Inc.*, 231 USPQ 881, 883 (TTAB 1986) ["While we do not doubt that these institutional purchasing agents are for the most part sophisticated buyers, even sophisticated purchasers are not immune from confusion as to source where, as here, substantially identical marks are applied to related products"]. That is, even relatively sophisticated purchasers of these goods are likely to believe that the goods come from the same source, if offered under the involved substantially similar marks.

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See Weiss Associates Inc. v. HRL Associates Inc., 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); and Aries Systems Corp. v. World Book Inc., 23 USPQ2d 1742, footnote 17 (TTAB 1992).

Decision: The refusal to register under Section 2(d) is affirmed in each application.⁴

⁴ On October 15, 2003, the Board reversed the Examining Attorney's refusal of registration based on Section 2(d) in applicant's related application Serial No. 76359028 for the mark SAHARA SAND for "drying agent used in the manufacture of road and traffic marking paint, and during the formation of markings on roadways."